

REMARKS

Applicant hereby responds to the Final Office Action of July 28, 2005, in the above-referenced patent application. Claims 1-32 were pending in the above-referenced patent application. The Examiner has withdrawn Claims 16-27 and 30-32 from consideration via a restriction requirement which Applicants address further below.

Claims 1, 9, 12, 28 and 29 were rejected under 35 USC 102(e) as being anticipated by USPN 6,324,694 to Watts et al. ("Watts"). Claims 1, 9-12, 28 and 29 were rejected under 35 USC 103(a) as being unpatentable over US Pub. No. 2002/0007493 by Butler et al ("Butler") in view of Watts. Claims 2-8, 13-15 and 17-20 were rejected under 35 USC 103(a) as being unpatentable over Butler in view of the specification. Applicant traverses all arguments and conclusions made in the Office Action. Claims 2, 25 and 26 have been amended to further clarify the invention and claim dependencies.

Restriction Requirement

The Examiner has withdrawn Claims 16-27 and 30-32 from consideration as being directed to an invention that is independent or distinct from the invention originally claimed. Applicant traverses this restriction requirement. The Examiner states that Claims 16-27 and 30-32 are newly submitted and are directed to Background Commercial Preferred Embodiments

which was not originally presented. Applicant respectfully disagrees for at least the following reasons.

The limitation of “Background Commercial” was clearly presented in at least independent Claim 16 as originally filed. In response to objections raised by the Examiner in the first office action, original Claims 16-19 were amended to overcome proper antecedent problems by correcting typos and further clarify the existing limitation of Background Commercials. Background Commercials were clearly recited in original Claim 16 before the first office action on the merits was issued. Further, the new dependent claims 21-32 which were added in response to the first office action are all dependent claims which add further limitations to original claims. Any limitations in Claims 16-27 and 30-32 which are directly or in directly related to Background Commercial embodiments of the present invention are not newly submitted embodiments since original Claim 16 included the Background Commercial limitation. Indeed, according to the embodiment in Claim 16, Background Commercials are directly related to Banner Information since Background Commercials include Banner Information. Accordingly, for at least the above reasons Applicant disagrees with the Examiner and respectfully traverses Examiner’s conclusion that Applicant constructively elected an original presentation which excludes limitations of claims 16-27 and 30-32. Further, claims 30-32 relate to obtaining/revoking user permission for Banner Information display. Applicant respectfully requests that finality of this action be withdrawn, and Claims 16-27 and 30-32 be examined on the merits in this application. Applicant respectfully submits that Claims 16-27 and

30-32 are patentably distinct over the references and arguments in the Office Action for at least the reasons provided herein. Applicant reserves the right to present further arguments in support of the claims upon examination on the merits.

Claim Rejections under 35 USC 102(e)

Rejection of Claims 1, 9, 12, 28 and 29 under 35 USC 102(e) as being anticipated by Watts is respectfully traversed because, for at least the following reasons, Watts does not disclose all of the claimed limitations.

Regarding **Claim 1**, the Examiner has not provided support for the conclusion that Watts discloses: “means for providing a combined digital signal, the combined digital signal having information reflective of a regular program signal and a Banner Information signal,” as required by Claim 1. The element 107 in Watts is preliminary content data, not a digital video service network as the Examiner interprets. Nowhere in Watts is a means providing a combined signal described or shown. Applicant respectfully requests that the Examiner clearly referring to such teaching in Watts.

Further, Watts does not disclose a combined digital signal having information reflective of a regular program signal and a Banner Information signal, as claimed herein. In col. 2, line 53 to col. 4, line 36 (relied on by the Examiner), Watts describes Fig. 1 wherein a receiver 105 receives content data 107 and a controller 135 receives subsidiary data 117. However, nowhere

does Watts describe a means for generating a combined signal that includes 107 and 117. Nor has the Examiner shown such disclosure in Watts. Watts states: “Data receiver 105 receives primary content data 107 from an external source (not shown), while subsidiary data control 135 receives subsidiary data 117 from another external source (not shown).” (col. 2, lines 59-63).

Watts is silent on a means for generating a combined signal as claimed.

Though Watts mentions that the source of subsidiary data 117 can be the source of content data 107, there is no mention in Watts of a combined digital signal, as claimed herein. Watts does not even mention that data 107 and 117 use the same channel, let alone disclose a combined digital signal. The Examiner has not met the burden of proof in showing that Watts generates a combined signal that includes data 107 and 117. Indeed, there is no need in Watts to combine the data 107 and 117 and Watts does not disclose any means that is utilizes to separate out the data 107 from the data 117 in a combined signal. The Examiner is reading disclosure into Watts that is simply not there. Just because the data 107 and data 117 may have the same source, this does not require that the data 107 and 117 are combined in a digital signal as required by Claim 1.

That data 107 and 117 in Watts are not in a combined signal as claimed is further shown by the fact that in col. 5, lines 28-33, Watts states: “In another mode of operation, subsidiary data control 135 forwards the subsidiary data directly to the display device upon receipt. In this mode of operation, reception logic 137 provides received subsidiary data 117 to synchronization logic

141, which in turn synchronizes subsidiary data 117 to primary content data 107. It is to be appreciated that subsidiary data 117 may be stored temporarily in system memory during this reception and synchronization process. This mode of operation may be used for example in situations where the portion of subsidiary data 117 corresponding to a currently received program of primary content data 107 is being received approximately concurrently with reception of the program.” As such, clearly in Watts the signals 107 and 117 are not parts of a single combined digital signal because they do not received concurrently. If data 107 and 117 arrived concurrently, then there would be no case in Watts wherein: “primary content data 107 is being received approximately concurrently with reception of the program.” Even if data 107 and 117 did arrive concurrently, Watts does not require that they be components of a combined signal as claimed herein.

Further, unlike the claimed invention wherein the regular program and the Banner information are sent synchronized as a combined digital signal and transmitted by the means for providing a combined digital signal, in Watts the data 107 and 117 are not combined and transmitted synchronized. Indeed, according to Watts transmission of the data 117 is independent of the primary data content 107 and the receipt of primary content data 107 and subsidiary data 117 are independent of each other (col. 4, lines 40-44). Upon receipt, logic 141 in Watts uses identification information for data 117 to synchronize the data 117 with data 107, and uses a programming database for timing, to display data 107, 117 (col. 5, lines 56-58; col. 6, lines 6-19; col. 6, line 53 to col. 7, line 7). Logic 141 is a synchronizer and not a controller that

controls the presentation unit to display the Banner Information with the regular program upon permission only, as claimed. By contrast, in Watts, if there is no data 117 then synchronizer 141 is disabled accordingly (col. 9, lines 6-30).

According to the present invention, once the end user has selected a channel or regular programming for viewing, the end user's digital TV Banner Information Receiver receives and demodulates the signal from the channel, decodes and delivers the regular TV programs to the user's presentation device, and also decodes, renders, and presents the Banner Information to the user's video presentation device upon user permission. For at least these reasons, and other reasons, it is respectfully submitted that rejection of Claim 1 and all claims dependent therefrom should be withdrawn.

Claim 9 was rejected for essentially the same reasons as rejection of Claim 1. It is respectfully submitted that Claim 9 should be allowed for at least the reasons provided above in relation to allowance of Claim 1.

As per **Claim 12**, in col. 9, lines 50-64 (relied on by the Examiner), Watts does not disclose providing a receiver to end users for simultaneous display of the Banner Information and the regular programming on the presentation unit, and controlling the presentation unit to display the Banner Information with the regular program only upon permission, as claimed. The claimed receiver and the controller of Watts operate differently. As discussed above, the system of Watts

and the present invention are different. For example, in Watts the data 107 and 117 are transmitted and received independent of one another. Further, the logic 141 in controller 504 in Fig. 5 of Watts requires identification and timing information for data 117 to synchronize data 117 with data 107 for display. By contrast, the regular program and Banner Information are combined and sent to a receiver in a combined digital signal, as claimed, which receiver uses the combined digital signal to simultaneously display the regular program and the Banner Information without the identification and timing information required by Watts. For at least these reasons, it is respectfully submitted that the receiver claimed herein is patentably distinct from the system 500 and controller 504 of Watts, and as such Claim 12 should be allowed.

Rejection of **Claims 28 and 29** is respectfully traversed for at least the reasons provided above.

Rejection of Claims 1, 9-12, 28 and 29 under 35 U.S.C. 103(a)

Rejection of Claims 1, 9-12, 28 and 29 under 35 U.S.C. 103(a) as being unpatentable over Butler in view Watts is respectfully traversed because at least for the following reasons no prima facie case of obviousness has been established, and the references, alone or in combination, do not disclose all of the claimed limitations.

Butler is directed to a video broadcast system including a broadcast source that broadcasts a video stream and provides accompanying supplemental data files. Each supplemental data file

is an HTML file having instructions for rendering a hyperlink overlay on the video stream (Abstract). However, according to **Claim 1**, a digital video service network comprises: means for providing a combined digital signal, the combined digital signal having information reflective of a regular program signal and a Banner Information signal; a receiver for receiving the combined digital signal and a presentation unit for displaying the combined digital signal, the Banner Information being presented to the presentation unit with the regular program; a controller that controls the presentation unit to display the Banner Information with the regular program upon end user permission only. By contrast to the present invention, in Butler the video stream is transmitted to the receiver first, and subsequently the HTML files are transmitted.

Further, the Banner Information herein is different from the hyperlink overlays in Butler. A hyperlink is simply links to other pages, requiring a user to click on the link to access the other pages for information. The Examiner interprets Butler's hyperlinks as Banner Information claimed herein. This is respectfully traversed. The Banner Information herein is defined as content in the forms of texts, graphics, images, or, any other type of audio visual information which is intended for commercial advertisement and can be presented to the user with any other type of digital television presentation. A hyperlink overlay on the video stream links to other pages which the user operates on to access information. This is a two step process, which the user must go through to get access to the information intended by the sender to be seen by the user. This is typical of Internet technology and web sites which flood the user with hyperlinks to other information, rather than the claimed one step process wherein the Banner Information is

presented to the user without need for user to necessarily click on a hyperlink, but with user permission.

The Examiner is misinterpreting Banner Information without justification that can be found within the specification. Further, according to Butler, a receiver is configured to receive the video stream and accompanying supplemental data files and to display the hyperlink overlays in conjunction with the video stream. The receiving equipment is configured to render video only in display areas that are set to the color key value. Thus, the video stream is rendered "behind" the hyperlink overlays, and the backgrounds of the overlays appears transparent (Abstract). Butler is directed to providing programming on computers and using existing standards which provide for hyperlinks on computers (Para. [0007] and [0008]). Despite the Examiner's interpretation, this is a limitation in Butler that is a consequence of using hyperlink "overlays" rather than displaying Banner Information and regular programming together on a display without such limitation, as claimed. In addition, in contrast to the claimed invention, there is no controller in Butler that allows a user to disable display of hyperlink overlay.

Further, as discussed further above, Watts does not teach Claim 1. The logic 141 in Watts is a synchronizer which operates by requiring identification and timing information for data 117 to display data 117 with data 107. It is well settled that in order for a modification or combination of the prior art to be valid, the prior art itself must suggest the modification or combination, "...invention cannot be found obvious unless there was some **explicit** teaching or

suggestion in the art to motivate one of ordinary skill to combine elements so as to create the same invention.” *Winner International Royalty Corp. v. Wang*, No. 96-2107, 48 USPQ.2d 1139, 1140 (D.C.D.C. 1998) (emphasis added). “The prior art **must provide** one of ordinary skill in the art the **motivation** to make the proposed molecular modifications needed to arrive at the claimed compound.” *In re Jones*, 958 F.2d 347, 21 USPQ.2d 1941, 1944 (Fed. Cir. 1992) (emphasis added). No motivation or suggestion is provided in the references to combine them as the Examiner does.

Indeed, Butler teaches away from the claimed invention and the modification suggested by the Examiner. Butler specifically criticizes systems such as Watts which provides a different standard and protocol specific to Watts. Butler states that: There has been no widespread acceptance of any interactive television system. One impediment to such widespread acceptance is that each system uses different standards and protocols for providing data that is ancillary to the primary video content. Unless a single system is instituted as a standard, broadcasters will have to provide ancillary data in numerous different formats. This is a significant impediment.” (Para. [0007]). Butler then goes on to provide a solution to overcome such non-standard systems, stating: “The invention removes this impediment by utilizing conventional formats for providing ancillary data along with video broadcasts, along with a scheme for overlaying digital data content on the primary video stream.” (Butler, Para. [0008]). As such, Butler teaches away from the present invention which provides specific combiners, transmission protocols and receivers to end users, and criticizes non-standard systems such as Watts which Butler is

attempting to get away from. Therefore, one of ordinary skill in the art would not look to Butler for a solution provided by the present invention. One of ordinary skill in the art knowing of Butler, would not then look to Watts to modify Butler according to Watts which requires non-standard transmission, delivery and reconstruction protocols including a controller 504 specific to Watts.

Further, modifying Butler to require user permission for showing the hyperlinks overlays goes against Butler's stated purpose of utilizing conventional formats for providing ancillary data along with video broadcasts, along with a scheme for overlaying digital data content on the primary video stream. Indeed, there is no mention or motivation in Butler to ask for user permission. Nor would such a concept be inline with Butler since the hyperlinks are sent to the user whether or not the user wants them. By contrast, the present invention is based on a model wherein the user is desirous of receiving Banner Information by providing such permission through a user interface implemented in the receiver which is provided to the user by contract/subscription, not disclosed by prior art.

Even if the modification was legally justified, it still would not render Applicants' claimed invention obvious. The Examiner admits that Butler does not teach all limitations in Claim 1. Further as discussed Watts fails to teach all of the limitations of Claim 1. Therefore, the Examiner attempts to modify Butler by Watts in order to teach Applicant's claimed invention, not based on disclosure or suggestion in the references, but based on Examiner's

lacking interpretation of the references in the nature and extent of the disclosures therein. If based on the Examiner's suggestion the logic circuit 141 of Watts is added to Butler, then by definition Butler no longer uses standard formats for providing ancillary data along with video broadcasts, along with a scheme for overlaying digital data content on the primary video stream. Nor would such a modification fit into Butler's entire model. The Examiner is improperly using "hindsight" and the teachings of Applicant's own claimed invention in order to combine references to render Applicant's claims obvious. The Examiner improperly attempts to modify Butler in an attempt to achieve Applicant's claimed invention. For at least these reasons, rejection of Claim 1 and all claims dependent therefrom should be withdrawn.

Claim 9 was rejected for substantially the same reasons as Claim 1, and is therefore allowable for at least the reasons provided in relation to Claim 1. The cited paragraphs in the references, alone or in combination, do not disclose the claimed limitations as the Examiner interprets them. Further, as claimed herein, the combined signal (including the regular program and the Banner information) is transmitted over the channel. By contrast, in Butler the video stream is transmitted to the receiver first, and subsequently the HTML files are transmitted (Para. [0052]). Butler teaches against providing non-standard receivers to users for receiving and reconstructing regular programming and Banner Information on a display. Butler is against user permission for hyperlink overlays. Further, as discussed, circuit 141 of Watts is not useable within the model of Butler, and there is no sufficient legal basis to combine Watts and Butler. For at least these reasons rejection of Claim 9, and all claims dependent therefrom should be

withdrawn.

Rejection of **Claims 10 and 11**, as discussed, Butler does not disclose all of the limitations of base Claim 9. Further, as the Examiner also states, Butler does not disclose the claimed limitations. Applicant respectfully traverses the Examiner's conclusion that Applicant did not adequately counter Examiner's Official Notice as to the existence of service agreements that allow viewers to watch distributed programming and provide a limitation on the subscription charged to the end user. Applicant disagrees with the Examiner's interpretation of Applicant's clear traversal of that Official Notice in Applicant's response to the first office action as inadequate and admission of fact. Indeed, Applicant has adequately traversed, and again now traverses, such Official Notice by the Examiner since, as Applicant has argued that such limitations are teachings of the present invention and not disclosed by prior art. Further, the Examiner has not provided proper references in support of such conclusions in the Official Notice. If the claimed limitations are so well known, why has not the Examiner provided a single qualifying reference as prior art to the present invention which clearly discloses the claimed limitations rather than relying on Official Notice without more?

As discussed above, Examiner's interpretation of Applicant's response as admission of fact is erroneous and traversed for at least the aforementioned reasons. Applicant maintains that the prior art does not disclose the claimed limitations, and any examples used by the Examiner as prior art must be established by the Examiner as prior art under 35 U.S.C. 102 and 103 (which

the Examiner failed to do in this Office Action and in the previous Office Action). The Examiner did not establish in any of the Office Actions proper prior art which disclosed entering into an agreement with end users which allows for the simultaneous display of the Banner Information and the regular programming on the presentation unit (Claim 10). Nor did the Examiner establish in any of the Office Action proper prior art which discloses than an agreement provides for a limitation on the subscription charged to the end users (Claim 11).

The Examiner admits that Butler fails to teach all of the limitations of Applicant's claimed invention. However, the improper attempts to modify Butler in an attempt to achieve Applicant's claimed invention. There is no suggestion or motivation to modify Butler for entering into an agreement with end users which allows for the simultaneous display of the Banner Information and the regular programming on the presentation unit (Claim 10). Nor is there any suggestion or motivation to modify Butler wherein the agreement provides for a limitation on the subscription charged to the end users (Claim 11). There is no user control in Butler over the hyperlink overlays as claimed.

There is no reason for Butler's users to enter into an agreement for hyperlink overlays since the hyperlink overlays do no interrupt the video stream of Butler as commercials do. By contrast, since a typical commercial does interrupt video programming, according to claimed invention user agreements are utilized to provide uninterrupted programs wherein user has control over how those commercials are viewed (e.g., Banner Information). This is not even

necessary in Butler since the hyperlinks are simply an added feature, not a solution to otherwise interrupted regular programming. Butler's model is different from that of the claimed invention. For at least these reasons, rejection of Claims 10 and 11 should be withdrawn.

Regarding **Claim 12** it is respectfully submitted that for at least the above reasons Butler does not disclose a receiver device that specifically enables the simultaneous display of the Banner Information and the regular programming on the presentation unit. Further, Butler is directed to generic personal computers for displaying video with hyperlink overlays in a computing environment where the user clicks on the hyperlinks for access to information. By contrast, according to the present invention, a receiver has specialized components therein for receiving a combined signal of a regular program and banner information, to display both simultaneously according to end user permission. The receivers herein are patentably distinct from the general purpose personal computers utilized by Butler because the receiver is designed to receive the combined signal, decode the signal, extract the regular program and the Banner Information, determine permission for display, and then display the regular program and the Banner Information. Butler teaches against providing non-standard receivers to users for receiving and reconstructing regular programming and Banner Information on a display. Butler is against user permission for hyperlink overlays. Further, as discussed, circuit 141 of Watts is not useable within the model of Butler, and there is no sufficient legal basis to combine Watts and Butler. For at least these reasons rejection of Claim 12 should be withdrawn.

Rejection of **Claims 28 and 29** is respectfully traversed for at least the reasons provided above.

Rejection of Claims 2-8, 13-15 and 17-20 under 35 U.S.C. 103(a)

Rejection of Claims 2-8, 13-15 and 17-20 under 35 USC 103(a) as being unpatentable over Butler in view of the specification is respectfully traversed because at least for the following reasons no prima facie case of obviousness has been established. Instead of providing qualified prior art which discloses the claimed limitations, the Examiner interprets the specification of the present invention as admitting prior art to the present invention which the Examiner uses to reject the claims. The specification of the present invention does not in any way admit that the claimed limitations are prior art as the Examiner misinterprets the specification.

Regarding **Claim 2**, as discussed, Butler does not disclose all of the limitations of base Claim 1. Further, as the Examiner also states Butler does not disclose a TS Packetized combined signal. In addition, the information in the specification (relied on by the Examiner) is a general reference to MPEG-2 standard. As such, teaching of TS packetized combined digital signal for a regular program and Banner Information is disclosed by the present invention. There is no suggestion or motivation in Butler to utilize TS packetized combined digital signal for a regular program and Banner Information as claimed herein. It is well settled that in order for a modification or combination of the prior art to be valid, the prior art itself must suggest the modification or combination, "...invention cannot be found obvious unless there was some

explicit teaching or suggestion in the art to motivate one of ordinary skill to combine elements so as to create the same invention.” *Winner International Royalty Corp. v. Wang*, No. 96-2107, 48 USPQ.2d 1139, 1140 (D.C.D.C. 1998) (emphasis added). “The prior art **must provide** one of ordinary skill in the art the **motivation** to make the proposed molecular modifications needed to arrive at the claimed compound.” *In re Jones*, 958 F.2d 347, 21 USPQ.2d 1941, 1944 (Fed. Cir. 1992) (emphasis added). There is no motivation or suggestion in Butler, or other prior art, to modify Butler as suggested by the Examiner.

Even if the modification was legally justified, it still would not render Applicants’ claimed invention obvious. The Examiner admits that Butler does not teach all limitations in Claim 2. Therefore, the Examiner attempts to modify Butler in order to teach Applicant’s claimed invention. However, as discussed, there is no teaching in Butler of the claimed limitations. It is respectfully submitted that the Examiner has again failed to meet the burden of establishing a prima facie case of obviousness.

The effort required to combine the teachings of Butler and MPEG-2 standard to combine a regular program and Banner Information as TS packetized combined digital as claimed would require a substantial undertaking and numerous elements which would not be obvious. The Examiner has not addressed these issues at all and simply uses a “why not approach” for one of ordinary skill in the art combining these references. The test of obviousness is not shifting the burden of proof to Applicant to show why one of ordinary skill in the art would combine the

references, rather the Examiner must establish that the references disclose the claimed limitations, and that there is motivation and suggestion in the references to combine them. Applicant has set forth concise arguments showing why Butler does not disclose the claimed limitations, and how just the knowledge of MPEG-2 in conjunction with Butler is insufficient to motivate a combination to render the claims obvious. Does the Examiner state that because MPEG-2 is generally known, then any invention that uses MPEG-2 would simply plug-it in and so render the invention obvious?

The *general* reference to MPEG-2 in Butler in conjunction with MPEG-2 standard definition is not a disclosure of the claimed limitations. Just because Butler mentions MPEG-2 it does not mean that Butler teaches how to use MPEG-2 to achieve the claimed limitations. Indeed, there is no teaching or suggestion in Butler that a TS packetized signal can even be used. Where is that disclosed or suggested in Butler?

The Examiner is improperly using “hindsight” and the teachings of Applicant’s own claimed invention in order to combine references to render Applicant’s claims obvious. The Examiner admits that Butler fails to teach all of the limitations of Applicants’ claimed invention. However, the Examiner improperly attempts to modify Butler in an attempt to achieve Applicant’s claimed invention. Though MPEG-2 may be within the general knowledge of one of ordinary skill in the art, Applicant respectfully submits that that does not mean that simply because Butler mentions MPEG-2, the one of ordinary skill in the art would have then been clued

into using a TS packetized signal in Butler. For at least these reasons, rejection of Claim 2 should be withdrawn.

Regarding **Claim 3**, as discussed Butler does not disclose of base Claim 1. Further, Butler does not disclose that: the means for providing a combined digital signal further comprises a first coding unit for coding the regular program signal and a second coding unit for coding the Banner Information signal, a first TS packetization unit for receiving the coded regular program signal and providing a packetized bit stream reflecting the coded regular program signal and a second TS packetization unit for receiving the coded Banner Information signal and providing a packetized bit stream reflecting the coded Banner Information signal, a TS Packet multiplexer for receiving the packetized regular program signal and the packetized Banner Information signal and providing a multiplexed transport stream, and a channel modulation unit for modulating the transport stream into the combined digital signal and sending the combined digital signal for transmission to the channel, as required by Claim 3.

In addition, the information in the specification (relied on by the Examiner) is a general reference to MPEG-2 standard. As such, teaching of Claim 3 is disclosed by the present invention. There is no suggestion or motivation in Butler to utilize such teachings for TS packetized combined digital signal of a regular program and Banner Information as claimed herein.

Even if the modification was legally justified, it still would not render Applicants' claimed invention obvious. The Examiner admits that Butler does not teach all limitations in Claim 3. Therefore, the Examiner attempts to modify Butler in order to teach Applicant's claimed invention. However, as discussed, there is no teaching in Butler of the claimed limitations. It is respectfully submitted that such an argument by the Examiner does not meet its burden of establishing a prima facie case of obviousness. The effort required to combine the teachings of Butler and MPEG-2 standard to combine a regular program and Banner Information as TS packetized combined digital as claimed in Claim 3 would require a substantial undertaking and numerous elements which would not be obvious. The general reference to MPEG-2 in Butler in conjunction with MPEG-2 standard definition is not a disclosure of the claimed limitations. Indeed, there is no teaching or suggestion in Butler that a TS packetized signal as in Claim 3 can even be used. The Examiner is improperly using "hindsight" and the teachings of Applicant's own claimed invention in order to combine references to render Applicant's claims obvious. The Office Action admits that Butler fails to teach all of the limitations of Applicant's claimed invention. However, the Office Action improperly attempts to modify Butler in an attempt to achieve Applicant's claimed invention.

Similarly, regarding the limitation of a channel modulation unit for modulating the transport stream into the combined digital signal and sending the combined digital signal for transmission to the channel (required by Claim 3), there is no such disclosure in Butler. A "modulation" function of any sort is not even discussed or mentioned in Butler. It is respectfully

submitted that the Examiner is improperly reading limitations into Butler that are not there. There is no modulation disclosure in para. [0013] or [0032] of Butler, as claimed herein. The Examiner has not shown that any modulation used in Butler, if any, has anything to do with the claimed limitations. For at least these reasons, rejection of Claim 3 should be withdrawn.

Claim 15 was rejected for similar reasons as rejection of Claim 3. As such, it is respectfully submitted that rejection of Claim 15 should be withdrawn for at least the reasons provided above in relation to Claims 3, and 9.

Claims 4-7, 13, 14 and 17-20 were rejected essentially based on elements 60, 66 and 68 of Butler. Rejection of these claims is respectfully traversed because as discussed Butler does not disclose limitations of base claims 1, 9 and 16. Further, in the Office Action the Examiner has simply referred to tuner 60 of Butler, without specific reference to relevant description in Butler, and has summarily interpreted tuner 60 to disclose several of the claimed limitations herein (i.e., a channel demodulation unit, a TS demultiplexer unit, etc.). This is without pointing to disclosure in Butler that states that the tuner 60 discloses such claimed limitations. The Examiner has provided his position as to why the Examiner interprets the tuner 60 and other elements as he does. However, the rejection must be based on disclosure in the reference, and not the Examiner's general interpretation of the reference as convenient for rejecting the claims. The Examiner has generally referred to paragraphs [0032] - [0039] of Butler, without any clear statement where in such paragraphs each specific limitation is disclosed. It is respectfully

submitted that no such limitations are disclosed in Butler regarding element 60 or any other element. If the Examiner believes otherwise, Applicant respectfully requests that the Examiner specifically point to such description in Butler. The Examiner has not met its burden of showing where such claimed limitations are disclosed in Butler.

Again, in the Office Action the Examiner has simply referred to video subsystem 66 of Butler, without specific reference to relevant description in Butler, and has summarily interpreted element 66 to disclose several of the claimed limitations herein (i.e., a Banner Information TS depacketizer, a Rendering Unit, a video reconstruction unit, Audio/video decoders, etc.). This is without pointing to disclosure in Butler that states that the element 66 discloses such claimed limitations. The Examiner has generally referred to paragraphs [0032] - [0039] of Butler, without any clear statement as to where in such paragraphs each specific limitation is disclosed. It is respectfully submitted that no such limitations are disclosed in Butler regarding element 66 or any other element. If the Examiner believes otherwise, Applicant respectfully requests that the Examiner specifically point to such description in Butler. The Examiner has not met its burden of showing where such claimed limitations are disclosed in Butler.

In addition, regarding Butler and the above MPEG-2 standard, there is no suggestion or motivation in Butler to utilize such teachings for TS packetized combined digital signal of a regular program and Banner Information as claimed herein. Even if the modification was legally justified, it still would not render Applicants' claimed invention obvious. The Examiner admits

that Butler does not teach all limitations of the claims. Therefore, the Examiner attempts to modify Butler in order to teach Applicant's claimed invention. However, as discussed, there is no teaching in Butler of the claimed limitations. What the Examiner calls the details associated with the implementation without specific reference to Butler as discussed, are not trivial or obvious. It is respectfully submitted that such an argument by the Examiner does not meet its burden of establishing a prima facie case of obviousness. The effort required to combine the teachings of Butler and MPEG-2 standard to combine a regular program and Banner Information as TS packetized combined digital as claimed would require a substantial undertaking and numerous elements which would not be obvious. The general reference to MPEG-2 in Butler in conjunction with MPEG-2 standard definition is not a disclosure of the claimed limitations. Indeed, there is no teaching or suggestion in Butler that a TZ packetized signal as claimed can even be used. The Examiner is improperly using "hindsight" and the teachings of Applicant's own claimed invention in order to combine references to render Applicant's claims obvious. The Office Action admits that Butler fails to teach all of the limitations of Applicant's claimed invention. However, the Office Action improperly attempts to modify Butler in an attempt to achieve Applicant's claimed invention. For at least these reasons, rejection of claims 4-7, 13, 14 and 17-20, should be withdrawn.

Claim 8 was rejected for essentially the same reasons as rejection of Claims 1, 3 and 4, and as such Claim 8 is allowable for at least the reasons provided above in relation to Claims 1, 3 and 4.

CONCLUSION

If necessary, the Commissioner is hereby authorized to charge payment or credit any overpayment to Deposit Account No. 01-1960 for any additional fees required in connection with this filing. A copy of this page is enclosed for this purpose.

For these, and other, reasons, Applicants believe that the claims are in condition for allowance. Reconsideration, re-examination, and allowance of all claims are respectfully requested.

<p align="center"><u>CERTIFICATE OF MAILING</u></p> <p>I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: MS AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on September <u>27</u>, 2005.</p> <p>By Sarah A. Nielsen</p> <p><u>Sarah A Nielsen</u></p> <p>Signature</p>

Respectfully submitted,


Kenneth L. Sherman9/27/05
(Date)

Registration No. 33,783

Myers Dawes Andras & Sherman, LLP

19900 MacArthur Blvd., 11th Floor

Irvine, CA 92612

(949) 223-9600

(949) 223-9610 – Fax

USPTO Customer No.: 23386